

Appl. No.: 10/771,902
Amtd. Dated: 08/19/05
Off. Act. Dated: 05/19/05

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. **Objection to Claims 12-16 for informalities.**

Claims 12-16 were objected to for informalities, with the claim dependency being recited as "claim 100". These claims were amended to correct the dependency in the manner that Examiner has surmised, specifically for dependency to parent Claim 11.

Applicant apologizes for any inconvenience caused by the mistake.

2. **Rejection of Claims 1-28 under 35 U.S.C. § 102(e).**

Claims 1-28 were rejected under 35 U.S.C. § 102(e) as being anticipated by Whitham (U.S. Publication No. 2003/0009281).

(In studying the Whitham reference, application number 09/009,161, it was found that the Whitham publication was issued as U.S. Patent No. 6,526,351 on February 25, 2003.)

The Applicant has carefully considered the grounds for rejection and responds as follows.

In general it should be recognized that Whitham teaches a device for conducting a tour, even the title "INTERACTIVE MULTIMEDIA TOUR GUIDE" reflects this purpose of the invention. The ABSTRACT also reflects this purpose, such as in the first sentence: "*An interactive multimedia tour guide provides a user with packaged tours in a multimedia format that includes directions and useful information about a selected tour*". (emphasis added) In keeping with being a tour guide, the device of Whitham provides tour opportunities based on the relationship between the tour defined in memory and the location of the user in relation to the defined tour. Although the user can add to the tour or add new points of interest during the tour, the system of Whitham still operates based on the tour and user entry.

Appl. No.: 10/771,902
Amdt. Dated: 08/19/05
Off. Act. Dated: 05/19/05

By contrast, the claims at issue in the instant application are directed to providing information about nearby photo opportunities. The user can randomly move about an area while the system of the instant application will provide a hierarchy of suggestions based on their user profile and current location, a location that need not be associated with a tour or contained in a prepackaged tour, or added by the user. Therefore, the user need not immediately enter anything for the device to make suggestions; even the user profile itself can be generated based in prior collected images thus eliminating the need to even perform a setup process for the device. .

Providing sufficient support for an anticipation rejection requires that every claim element must be taught or inherent in a single prior art reference, Manual of Patent Examining Procedure (MPEP) §706.02a. The pending claims are not therefore anticipated by the relied-upon references.

Applicant respectfully asserts that the presently claimed invention is patently distinct from the cited references, and the Applicant therefore requests that the present rejections be withdrawn and the instant application passed to allowance.

In addition, numerous additional aspects of the invention contain elements not taught by the Whitham reference. In many cases the Applicant has amended the claims to more clearly recite aspects of the invention and in some cases to even further distinguish these aspects of the invention.

In relation to obviousness, it should be recognized that Applicant alone solved the problem of providing the photo opportunity suggestions without the need to first get real-time input from the user by way of establishing a tour path, adding ancillary points of interest, or directing the device to provide information on a specific type of point of interest. The importance of this should not be overlooked as brought out by the MPEP.

MPEP 2141.02 - "A patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103.

The following discusses the rejection of each of the claims.

Appl. No.: 10/771,902
Amdt. Dated: 08/19/05
Off. Act. Dated: 05/19/05

Claim 1. Independent Claim 1 is drawn to a method, amended to recite that of identifying photographic opportunities. In support of the rejection the Examiner has considered Whitham to disclose:

"A method comprising:

sensing a user profile (paragraph 45);

determining a geographic location of a device (paragraph 57);

transmitting at least one suggestion to the device based on the geographic location of the device and the user profile wherein the suggestion indicates a photo opportunity (paragraph 20, paragraph 65)."

However, a number of shortcomings arise in that support. First, the above description of Whitham is not correct. For one thing the description does not mention that in using the device of Whitham the user must be following a tour, the points are contained in the tour. The unit of Whitham generates data on points of interest along a tour route.

In putting forth the rejection the Examiner contends that paragraphs 20 and 65 describe the above elements. The following discusses those paragraphs in the reference.

Paragraph 20 of Whitham describes the user on a prepackaged tour. In this tour the user has the option to enter information to include ancillary (definition from Microsoft Encarta 2001: "Subordinate in a position of lesser importance") points of interest. Wherein the defined tour is still the main object. The preceding paragraph makes clear that the user is of necessity following the tour: "...displays a map of the selected tour...", "...once a tour is initiated...", and so forth.

Paragraph 65 also discloses that the system operates on the principle of following a tour. All location information is based on the tour which has been initiated,

Appl. No.: 10/771,902
Amdt. Dated: 08/19/05
Off. Act. Dated: 05/19/05

for example it is stated: "*The location information is used in function block 810 to access the GIS database downloaded from the user's personal computer for the selected tour, or stored on the portable self-contained system of FIG. 5.*" (emphasis added).

Consequently, Whitham is a device for following a tour, the tour being predetermined or for which user input can be collected for ancillary points of interest. Refer to the flowchart of FIG. 3A through FIG. 3E, it will be noted that the first operations performed are always that of selecting a specific tour, which would have a number of sites associated with it. Applicant's invention as claimed in Claim 1 does not locate the photographic opportunities in relation to a tour that the user is following. Claim 1 of the instant application by contrast describes the user receiving photo opportunity suggestions automatically in response to the location of the device in relation to photo opportunities which fit the user profile. A number of benefits can accrue from Applicants invention, for example, there is no need to load a tour, or for the user to remain following a tour path, or for the user to load ancillary points of interest along a tour route. These benefits are inherent in the Applicant's invention and these aspects of the invention must be given patentably weight as described according to MPEP 716.02(f) Advantages Disclosed or Inherent.

In the rejection, however, this crucial aspect of the Whitham reference has not been considered. Claim 1 foregoes the necessity of following a programmed tour, and is thus not anticipated by the relied upon reference.

Therefore, in view of the lack of anticipation as described, the Applicant respectfully requests that the rejection of Claim 1 and the claims which depend therefrom be withdrawn.

Claim 2. Claim 2 is a dependent claim which has been amended to recite a beneficial aspect of the invention. Specifically, that the "*user profile is created based on*

Appl. No.: 10/771,902
Amdt. Dated: 08/19/05
Off. Act. Dated: 05/19/05

photographs captured by the user". Support for this is found in the instant application, such as including page 9, lines 1-4. This is an aspect of the invention not found within the Whitham reference.

Claim 3. Claim 3 is a dependent claim which has been amended to recite that the step of "*identifying a plurality of suggestions*" is performed by: "*generating a desired number of listings in response to dynamically varying the radius of geographic limits*". This aspect of the invention is not described by Whitham and provides a number of benefits for the present invention, which is not bound to following a predetermined tour. The user is automatically given a list of suggestions, deemed pertinent to them in response to the user profile, regardless of where they are located, without the need of loading a prepackages tour, without the need of defining tour points and ancillary points of interest, without having to do anything other than view the list of photo opportunities available to them.

Support is found in the specification for the dynamic varying of the radius of geographic limits, including page 15, lines 3-9.

Claim 10. Independent Claim 10 is directed at a system of identifying photographic opportunities. Claim 10 has been amended to include the aspect in which a desired number of suggestions is generated in a list to the user in response to dynamically varying the radius of geographic limits. This aspect was claim in amended Claim 3, and support is found in the specification, such as at page 15, lines 3-9.

Claim 10 is not anticipated by the Whitham reference as it does not describe generating suggestions along a tour route. In addition, the generation of a desired number of suggestions within a listing as based on varying dynamic radius of geographic limits is also not described by the cited reference.

Appl. No.: 10/771,902
Amdt. Dated: 08/19/05
Off. Act. Dated: 05/19/05

Therefore, Applicant respectfully requests that the rejection of Claim 10, and the claims which depend therefrom, should be withdrawn.

Claim 11. Independent Claim 11 describes a method. Claim 11 does not describe providing points of interest constrained along a tour route, but instead generates lists of suggestions automatically without the need to define a tour route, or be on a tour, or define a tour, or otherwise provide any prior information about what one desires to see. Therefore, Claim 11 describes a method that is not anticipated by the Whitham reference.

In addition, amended Claim 11 describes generating a desired number of suggestions within a listing in response to dynamically varying the radius of geographic limits. This aspect is also not described by, not anticipated by, the Whitham reference.

Therefore, Applicant respectfully requests that the rejection of Claim 11, and the claims which depend therefrom, should be withdrawn.

Claim 21. Independent Claim 21 describes a system for suggesting local photo opportunities. Claim 21 also is not anticipated by Whitham as the claim clearly does not depend on suggesting photo opportunities along a tour route.

In addition, amended Claim 21 describes an additional aspect of the review module in which it creates a user profile based on prior photographs taken by the user. It should be appreciated that Whitham is not configured for creating the user profile in this manner.

Therefore, Applicant respectfully requests that the rejection of Claim 21, and the claims which depend therefrom, should be withdrawn.

Appl. No.: 10/771,902
Amdt. Dated: 08/19/05
Off. Act. Dated: 05/19/05

Claim 28. Independent Claim 28 is drawn to a computer readable medium.

Claim 28 is similar to Claim 1, but is drawn to the computer executable medium. Similar arguments in support of non-anticipation can be put forth for Claim 28 as were put forth for Claim 1. It will be appreciated that Claim 28 also recites generation of photo opportunity suggestions which are not constrained along a tour route, or based on ancillary points of interest added by the user, or in response to an immediate user request for a specific types of site.

Therefore, in view of the lack of anticipation by the relied-upon reference, Applicant respectfully requests that the rejection of Claim 28 be withdrawn.

Claims 2-6, 8, 12-20, 22-27, and 29-30. Dependent Claims 2-6, 8, 12-20, 22-27, and 29-30 should be considered a *fortiori* allowable in view of the discussed non-anticipatory nature of the respective base claims.

It should also be appreciated that a number of these claims recite elements that are not described in the relied upon reference and provide their own grounds for non-anticipation. The following are described by way of example.

Claims 17-18. Dependent claims 17-18 describe steps of comparing captured images with sample images, with Claim 18 describing how descriptive text is added in response to a match found during comparison. Support for the rejection incorrectly indicates that Whitham performs these functions. No specific elements within the relied upon sections of Whitham, specifically paragraph 49, paragraph 56, and paragraphs 72-74, pointed out matching elements, not is the applicant able to find any information which would lead one to conclude that Whitham provides this feature.

Paragraph 49 of Whitham describes selecting ancillary points of interest, the closest aspect described is that of showing slides that provide more in depth explanation of ancillary points of interest.

Appl. No.: 10/771,902
Amdt. Dated: 08/19/05
Off. Act. Dated: 05/19/05

Paragraph 56 of Whitham describes a camera with GPS and communications capability. Again, nothing exists in the relied-upon section which comports to the above section of Claims 17-18.

Paragraphs 72-74 of Whitham (*spanning almost an entire page of two columns*) describes following a tour and the storage of images and video.

Accordingly there is no support for an anticipation rejection of Claims 17-18.

Claim 19. Dependent Claim 19 is drawn to a method of updating the user profile in response to images captured by the device.

Therefore, although all the dependent claims stem from parent claims whose non-anticipation of the reference have been discussed, they in many cases provide separate patentability over their respective base claims. The rejection of these claims should be withdrawn.

3. Traversal of Rejection of Claim 10; In re Donaldson.

The Applicant respectfully traverses the grounds for rejection, and cites *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc) as the basis for the traversal. Claim 10 is written in means plus function form pursuant to 35 U.S.C. §112, sixth paragraph, and therefore, must be interpreted during examination under *In re Donaldson*.

In rejecting Claim 10, as well as the claims that depend therefrom, the Examiner made no specific fact findings as to the scope of equivalents for the means plus function elements in the claims. Instead, the Examiner appears to have followed the provisions of MPEP § 2183 ("Making a Prima Facie Case of Equivalence"), which states:

If the examiner finds that a prior art element performs the function specified in the claim, and is not excluded by any explicit definition provided in the specification for an equivalent, the examiner should infer from that finding that

Appl. No.: 10/771,902
Amdt. Dated: 08/19/05
Off. Act. Dated: 05/19/05

the prior art element is an equivalent, and should then conclude that the claimed limitation is anticipated by the prior art element. The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure ... disclosed in the application. *In re Mulder*, 716 F.2d 1542, 219 U.S.P.Q. 189 (Fed. Cir. 1983). No further analysis of equivalents is required of the examiner until applicant disagrees with the examiner's conclusion, and provides reasons why the prior art element should not be considered an equivalent.

While the Examiner appears to have followed the provisions of MPEP §2183, such provisions are contrary to Federal Circuit law. The Federal Circuit has held that an examiner "construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure ... described therein, and equivalents thereof," *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc), and in so ruling expressly denied that "the PTO is exempt from this mandate." *Id.* The Federal Circuit added that it was specifically overruling any precedent that suggested or held to the contrary. *Id.* at 1193-94. In response to the PTO's argument that the court's ruling conflicted with the principle that a claim should be given its broadest reasonable interpretation during prosecution, the Federal Circuit held that the *Donaldson* decision was setting "a limit on how broadly the PTO may construe means-plus-function language under the rubric of 'reasonable interpretation.'" *Id.* at 1194. In other words, an examiner's claim interpretation is not "reasonable" if it is not based on the specification's description of the implementation of the means element of the claim. The court then said, "Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such [means-plus-function] language when rendering a patentability determination." *Id.* at 1195.

Appl. No.: 10/771,902
Amdt. Dated: 08/19/05
Off. Act. Dated: 05/19/05

Here, as in *Donaldson*, the Examiner is required by statute to look to the Applicant's specification and construe the "means" language as referring to corresponding means disclosed in the specification and equivalents thereof." See *id.* at 1195. However, the Examiner did not construe the means language of these claims, however. Nor did the Examiner find, on the basis of specific facts of record here, that the means disclosed in the Applicant's specification were equivalent to that of the cited references. Instead, as prescribed by MPEP §§ 2183-84, the Examiner simply presumed equivalence. The presumption methodology used here, which the MPEP prescribes, clearly conflicts with the requirements of the Federal Circuit's *Donaldson* decision. The approach taken by the Examiner in this case also conflicts with *In re Bond*, 931 F.2d 831 (Fed. Cir. 1990).

The very point of these cases is that, in this context, limitations from the specification control the interpretation of the claim. Under §112, paragraph 6, a means-plus-function element of a claim must be construed to mean that which is disclosed in the specification and its equivalents. In *Donaldson*, the Federal Circuit said that "our holding does not conflict with the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim." In other words, the court was saying that a §112, paragraph 6 "means" element does not need to be "imported or read into" a means-plus-function claim because the specification's limitations and their equivalents are already in the claim by virtue of §112, paragraph 6's command. Thus, the Federal Circuit said (16 F.3d at 1195): "What we are dealing with in this case is the construction of a limitation already in the claim in the form of a means-plus-function clause and a statutory mandate on how that clause must be construed."

Based on the foregoing, the Applicant respectfully submits that the rejection of Claim 10, as well as the claims that depend therefrom lacks proper foundation and that the rejection should be withdrawn. Those claims, each of which include means plus

Appl. No.: 10/771,902
Amdt. Dated: 08/19/05
Off. Act. Dated: 05/19/05

function limitations, should have been interpreted in view of the specification as required by *In re Donaldson*. If those claims had been so interpreted, they would have been allowable since the cited references do not, singly or in combination, teach, suggest or provide motivation or incentive for the subject matter recited in those claims.

4. Amendments to Claims 1-4, 6-16, 18-19, 21 and 28.

Claims 1-4, 6-16, 18-19, 21 and 28 were amended as described.

Claim 1. Independent Claim 1 was amended to clarify the language of the claim.

Specifically "sensing" was changed to the more precise "maintaining"; support for which is found on page 11, line 10.

Additional changes were made to clarify the meaning of terms within the claim, to avert any possible ambiguity.

Claim 2. Dependent Claim 2 was amended and redirected to describe how the user profile is maintained, specifically based on photographs captured by the user. Support for this change is found in the specification, such as at page 6, lines 14-16.

Claim 3. Dependent Claim 3 was amended and redirected to describe how a step of identifying the plurality of photo opportunity suggestions, in particular how in order to generate a desired number of suggestions generated in response to dynamically varying the radius of the geographic limits. Support is found in the specification, including page 15, lines 3-9.

Claim 4. Dependent Claim 4 was amended to incorporate the original Claim 3 and Claim 4 elements in the alternative.

Claim 6, 8. Dependent Claims 6 and 8 were amended to incorporate the elements of original Claim 7 and 9, respectively, which have been cancelled.

Claims 7, 9. Dependent Claims 7 and 9 were canceled after their material was incorporated in prior claims.

Claims 10-11. Independent Claims 10-11 were amended to include the

Appl. No.: 10/771,802
Amdt. Dated: 08/19/05
Off. Act. Dated: 05/19/05

limitations of amended Claim 3.

Claims 12-16. Dependent Claims 12-16 were amended to correct the reference to the parent claim from "100" to "11".

Claim 18. Dependent Claim 18 was amended to replace "comparing" which is a process, with a result "matching" as recited in Claim 17 to which Claim 18 depends.

Claim 19. Dependent Claim 19 was amended to reorder the description of using the image content for updating the user profiles.

Claim 21. Independent Claim 21 was amended to include the additional limitation on the review module of creating the user profile based on the prior photographs taken by the user. Support for which is found in the specification, including page 9, lines 1-4 and elsewhere.

Claim 28. Independent Claim 28 was amended to enhance the preamble and to add clarification elements as added to independent Claim 1.

5. Addition of Claims 29-30.

Claims 29-30. Dependent Claims 29-30 were added to recite aspects included in original claims 17-18, yet directed to Claim 1. These describe the aspects in greater detail support for which is found on page 17, line 20 through page 18 line 2.

6. Amendments Made Without Prejudice or Estoppel.

None of the amendments have been made for the purpose of overcoming any ground for rejection, the arguments present herein are considered to overcome all rejections. Applicants have made these amendments in order clarify the claimed material and expedite allowance of the subject matter. However, Applicants do not acquiesce in the original ground for rejection with respect to the original form of these claims. These amendments have been made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public, with respect to the original

Appl. No.: 10/771,902
Amdt. Dated: 08/19/05
Off. Act. Dated: 05/19/05

subject matter of the claims as originally filed or in their form immediately preceding these amendments. Applicants reserve the right to pursue the original scope of these claims in the future, such as through continuation practice for example.

7. Additional Claim Fees.

No additional claim fees are required. The two additional dependent claims (Claims 29-30) replace original Claims 7 and 9, which were canceled in this response.

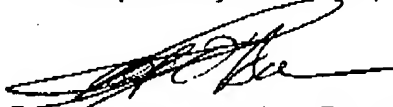
8. Conclusion.

Based on the foregoing, Applicant respectfully requests that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the arguments presented herein, and that a Notice of Allowance be issued for the present Application to pass to issuance.

In the event any further matters remain at issue with respect to the present Application, Applicant respectfully requests that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matters prior to the next action on the merits of this Application.

Date: 8/19/05

Respectfully submitted,



John P. O'Banion, Reg. No. 33,201
O'BANION & RITCHEY LLP
400 Capitol Mall, Suite 1550
Sacramento, CA 95814
(916) 498-1010